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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91181975
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JOANNA VILLENEUVE and)	
MÉLANIE VILLENEUVE,)	
)	
Opposers,)	Mark: GILLES VILLENEUVE
)	Serial No.: 79/030,057
v.)	Published: 18 September 2007
)	
GOLDSTAR HOLDINGS CORP.)	Opposition No. 91181975
)	
Applicant.)	
)	

Opposers Joanna Villeneuve and Mélanie Villeneuve (“Opposers”) submit this Opposition to Applicant Goldstar Holdings Corp.’s (“Goldstar’s” or “Applicant’s”) Second Motion to Dismiss pursuant to Fed. R. Civ. P. 12(b)(6). Goldstar argues that the Amended Notice of Opposition (“Opposition”) filed October 9, 2008, should be dismissed because the Opposers have failed to state a claim upon which relief can be granted. The motion should be denied because Opposers have properly alleged that, pursuant to Section 2(a) of the Lanham Act, they have the right to protest to the false association created by the unauthorized use of their husband and father’s name with Goldstar’s products. As grounds for its opposition to the Motion to Dismiss, Opposers further state as follows:

STATEMENT OF RELEVANT FACTS

The Amended Opposition alleges that the Opposers are heirs and beneficiaries of the estate of Gilles Villeneuve, a Formula One race car driver famous in the United States, as well as internationally, for his successful racing career. Amended Opposition ¶¶ 3-5. As such, upon his death Opposers succeeded to Mr. Villeneuve's interests in all his assets, including the trademark and publicity rights in the name GILLES VILLENEUVE. *Id.* ¶ 3. Opposers have further alleged that significant fame and goodwill are associated with his name in the United States and abroad, and Applicant Goldstar's attempt to trademark his name, if successful, would allow Goldstar to inappropriately trade on the goodwill and publicity rights which the Opposers hold in the GILLES VILLENEUVE name. *Id.* ¶¶ 5-8. Opposers assert that Goldstar has no right or connection to that name and its use of it would suggest a false connection to Mr. Villeneuve and the Villeneuve family, causing damage to the publicity rights held by Opposers. *Id.* ¶¶ 7-10.

STANDARD FOR A MOTION TO DISMISS

Alleging sufficient facts in the pleading context consists of asserting only a "short and plain statement." *Young v. AGB Corp*, 47 USPQ2d 1752, 1754 (TTAB 1998) (quoting 37 C.F.R. Section 2.104(a)). A motion to dismiss relies solely on the factual allegations of the pleadings, and "all well pleaded factual allegations of the 'complaint' are accepted as true and the 'complaint' is viewed in the light most favorable to the non-moving party." *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 , 1218 (TTAB 1990).

Further, "a motion to dismiss for failure to state a claim upon which relief can be granted must be construed by a tribunal, such as the Trademark Trial & Appeal Board, so as to do substantial justice. Dismissal for insufficiency is appropriate only if it appears certain that

opposer is entitled to no relief under any set of facts which could be proved in support of its claim. *See Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). This means that the tribunal must examine the entire pleading and, as required by Fed.R.Civ.P. 8(f), construe the allegations therein liberally, “to determine whether it contains any allegations, which, if proved, would entitle plaintiff to the relief sought.” *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1214 (TTAB 2006), *citing Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Finally, as long as the other side has sufficient notice of the claims, a claim can survive a motion to dismiss. The purpose of a motion is not “to determine the sufficiency of any evidence that might be adduced” but instead to only discard claims that are destined to fail. *Fair Indigo*, 85 USPQ2d at 1538. The Board has noted that “the purpose of notice pleading is to obviate the need to allege particular magic words.” *Id.*

ARGUMENT

The Opposition Should Not Be Dismissed For Failure To State A Claim

1. Opposers Have Satisfied All Requirements to Plead an Opposition Under Section 2(a).

The portion of Section 2(a) which bars the registration of a mark that would falsely suggest a connection with a living or dead person exists to protect and control the use of one’s identity. *Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S.*, 222 USPQ 512, 514 (TTAB 1984). The Board has recognized that there was a desire by the drafters of section 2(a) to recognize the right to privacy, or the related right of publicity, may be violated.

Id. That is what the Opposers are trying to protect — Mr. Villeneuve’s identity and reputation — and prevent an unauthorized company from appropriating his identity.

Section 2(a) protects an individual’s right to their persona/identity and prohibits a false suggestion of a connection. It requires the opposer to allege facts that could establish that:

(1) [t]he mark must be shown to be the same as or a close approximation of the person's previously used name or identity; (2) it (or part of it) would be recognized as such; (3) that the person in question is not connected with the goods or services of the applicant; and (4) the person's name or identity must be of sufficient fame that when it is used as part or all of the mark on applicant's goods, a connection with that person is likely to be made by someone considering purchasing the goods.

In re Debbie Sauer, 27 U.S.P.Q.2d 1073, 1074 (TTAB 1993), citing *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985). Additionally, an opposer must plead not only the likelihood of confusion as to source arising out of the use of a personal name, but also an intent by defendant to trade upon plaintiff’s goodwill. *See Springs Industries, Inc.*, 222 USPQ at 514. “The initial and critical requirement is that the name (or an equivalent thereof) claimed to be appropriated by another must be unmistakably associated with a particular personality or ‘persona.’” *Id.*

2. Applicant’s Mark is Identical to the Famous Name of Opposer’s Decedent.

The first element of the *Sauer* test is the “critical requirement” that the name claimed to be appropriated by applicant, here, GILLES VILLENEUVE, is unmistakably associated with a particular personality. This fact has been expressly alleged and is indeed beyond dispute. The purported mark GILLES VILLENEUVE is undeniably the name of Opposers’ late husband and father, Gilles Villeneuve. *See* Amended Notice of Opposition, ¶¶ 1 & 6. Opposers have also

alleged (and Applicant cannot deny) that Mr. Villeneuve was a world famous Formula One race car driver. *See* Amended Opposition ¶¶ 4-5. The Amended Notice of Opposition thus satisfies the first prong of the test, that the applicant's mark is the same as the Opposer's decedent's previously used name or identity. *See the Internet, Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1437 (TTAB 1996); *see also, Buffett v. Chi Chi's Inc.*, 226 USPQ at 429.

3. Applicant's Motion Mischaracterizes Both the Pleadings and Section 2(a).

Applicant argues that Opposers have failed to comply with this prong of the test, because "nowhere in the Amended notice is there any allegation that the Opposers are 'the prior user' in the United States." (Motion to Dismiss at 2). The only reasonable interpretation of this argument is that Applicant is intentionally misreading the plain language of section 2(a). Applicant's suggestion that prior use of a name necessitates some sort of prior *commercial* use within the United States is plainly wrong. It is well-established that a plaintiff can prevail under section 2(a) without having a previous commercial use of their name. *See Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 410 (TTAB 1986) (holding that "it is possible for a plaintiff to prevail under Section 2(a) even if the name claimed to be appropriated has never been commercially exploited as a trademark by the plaintiff."); *see also Buffett*, 226 USPQ at 429 (holding that "an opposer may prevail even if the name claimed to be appropriated has never been commercially exploited by the opposer in a trademark or trademark analogous manner."). All that is important is that the "petitioner's name or identity was and is of a sufficient fame or reputation that when registrant's mark is used on its goods ... a connection with the petitioner is presumed." *Board of Trustees of the University of Alabama*,

231 USPQ at 411. As required here, Opposers have alleged the fame of Gilles Villeneuve, in the United States, and, *a fortiori*, that famous identity is expressed through his name.

Moreover, by suggesting that under section 2(a), there should have been an allegation of some prior commercial use, Applicant intentionally conflates the requirements of section 2(a) with the requirements of section 2(d). The Board in *Springs Industries* expressly addressed the different rationales and reasoning behind these independent provisions of section 2 of the Act, noting that while section 2(a) tries to protect the rights of privacy and publicity, section 2(d) essentially is a trademark or trade name infringement claim. *Springs Industries, Inc.*, 222 USPQ at 513-514. Accordingly, the elements of each claim are distinctly different, and to “hold otherwise would be, in effect, to hold that Section 2(d) and that portion of Section 2(a) concerning the false suggestion of a connection with persons, living or dead, are identical claims under the Trademark Act. Such a holding would do violence to Section 14 of the Act, which makes a distinction between Section 2(a) claims...and Section 2(d) claims.” *Id.* at 514.

Additionally, Applicant complains that the Amended Opposition lacks an express allegation of “use” of decedent’s name specifically *in the United States*. However, as discussed above, what is required by section 2(a) is the allegation of Mr. Villeneuve’s *fame and identity*, not necessarily trademark or other commercial “use.” *Board of Trustees of the University of Alabama*, 231 USPQ at 411. Again, Opposers *have* alleged that Mr. Villeneuve was famous in the United States and had goodwill in the United States (Amended Opposition ¶¶ 3-5). Thus such an argument fails on its own terms (notwithstanding the fact that it also confuses sections 2(d) and 2(a)). This case is distinguished from *Canovas v. Venezia*, 220 USPQ 660 (TTAB 1983), where the Board found fault in a failure to specifically allege that the Opposer was

famous within the United States. In contrast, here, the Opposers specifically alleged that Gilles Villeneuve was famous in the U.S. *See* Amended Opposition, ¶ 5.

4. The Cases Cited by Applicant are Inapposite.

Applicant cites two cases, *In re Mohawk Air Services, Inc.*, 196 USPQ 851, 854-855 (TTAB 1977), and *In re Nuclear Research Corp.*, 16 USPQ2d 1316, 1317 (TTAB 1990), for the proposition that under Section 2(a) an opponent must show that they are a prior “user.” Those cases are entirely irrelevant: neither involved a person or personal identity. Both *Mohawk* and *Nuclear Research* dealt with organizations or entities that wanted to claim the use of a name or acronym as a mark associated with their organization or entity. Alleging that certain initials (letters which taken out of context could stand for anything) evoke a specific entity is not the same as protecting the name or identity of a person with sufficient fame that their name is recognizable. Here, there is no question that the mark at issue is the name of the late race car driver Gilles Villeneuve, that “Gilles Villeneuve” is associated only with that person, and the Opposers alleged that there would be a connection to him in the mind of the purchasing public. Amended Opposition ¶¶ 8-9 (“there is a very high likelihood that purchaser and potential purchasers of Applicant’s goods will be confused or deceived into believing that the goods have been authorized or endorsed by the Villeneuve family”). Using an acronym to represent an organization is very different from the use of a name to identify a person.

5. Opposers Have Adequately Pleaded the Second Element of a Section 2(a) Claim.

The second requirement under section 2(a) is that the mark would be recognized as such, in that it points uniquely and unmistakably to the identity or persona of the Opposers’ decedent. *See the Internet, Inc.*, 38 USPQ2d at 1437. Opposers have met this requirement by alleging that

Applicant's purported mark GILLES VILLENEUVE is identical to Opposer's decedent's full name. Amended Opposition, ¶ 6. They further alleged that the "Gilles Villeneuve" name is well known in the United States and abroad, and so would be recognized as referring to no one other than Gilles Villeneuve, the now deceased race car driver. *Id.*, ¶¶ 4-5. Moreover, given that the applicant's registration specifically refers to goods related to auto racing (*Id.*, ¶ 6), the connection between the race car driver and the mark has been implicitly recognized by the fact of the application itself.

6. Opposers Have Clearly Alleged Applicant's Lack of Connection.

The third element in the *Sauer* formula is that "the person in question is not connected with the goods or services of the applicant." 27 U.S.P.Q.2d at 1074. Opposers have satisfied this requirement because they have alleged that "Applicant has no ownership or other rights in the name, likeness, image or personality of Gilles Villeneuve to support a claim of trademark rights in GILLES VILLENEUVE." Amended Opposition ¶ 7. Opposers have also asserted facts sufficient to establish their own connection to, and rights in, the name. As a matter of the applicable probate law, Opposers (*not* Goldstar) succeeded to Mr. Villeneuve's rights in his identity upon his death. *See* Amended Opposition, ¶ 3.

7. Opposers Have Alleged Fame and Likelihood of a Connection.

The fourth requirement in the *Sauer* decision is that the person's name or identity must be of sufficient fame that, when it is used as part or all of the mark on applicant's goods, a connection with that person is likely to be made by someone considering purchasing the goods. 27 U.S.P.Q.2d at 1074. Opposers have pleaded ample facts sufficient to meet this prong. Opposers alleged that Gilles Villeneuve was and remains an iconic figure in the sport of Formula

One Racing in the United States and abroad. Amended Opposition, ¶¶ 4-5. Opposers have further alleged that purchasers will rely on a connection to Gilles Villeneuve when purchasing Applicant's goods, many of which are explicitly racing-related. Amended Opposition, ¶¶ 8-9. The Amended Notice of Opposition explicitly establishes the connection between the name and the purchase as required—that Mr. Villeneuve's fame and association with the auto racing world would lead the consumer to think that he was connected to the proposed racing and other merchandise. Moreover, as required by the Board in *Sauer*, Opposers also expressly alleged that Applicant would be trading, unfairly, on the goodwill associated with Mr. Villeneuve's renowned name. *See* Amended Opposition, ¶¶ 8-10. Accordingly, all the elements required by the Board to allege a 2(a) case are satisfied. *See Sauer*, 27 U.S.P.Q.2d at 1074.

8. Applicant's Suggestion that Opposers Cannot Allege Sufficient Facts is Disingenuous.

Applicant takes the position not only that Opposers have not alleged facts sufficient to support a Section 2(a) claim, but also that Opposers *cannot* allege such facts and should not even be permitted a chance to re-plead. As discussed above, Opposers have amply demonstrated that the current Amended Notice of Opposition clearly sets forth all of the facts necessary to establish a Section 2(a) claim. As such, the motion to dismiss should be denied and no further amended pleading should be necessary.

For Applicant to suggest, however, that the necessary facts cannot be pleaded stretches credulity – the very reason why Goldstar wants to register the mark is that Mr. Villeneuve's fame gives the mark substantial value. In any event, Opposers are prepared to introduce evidence of Mr. Villeneuve's undisputed fame and reputation in the United States, as well as the prior use of

his name and image on various merchandise (still available for purchase on sites such as eBay) offered during his lifetime by authorized parties such as his racing team. There are readily available articles and resources, predating the current application, which confirm Mr. Villeneuve's fame, the publication of which may be judicially noticed. For example, the Grand Prix website has an encyclopedia entry on Gilles Villeneuve, *see* <http://www.grandprix.com/gpe/drv-vilgil.html>. In addition, the *New York Times* and *Sports Illustrated* concurrently reported his death in their pages. *See* "Gilles Villeneuve, a Canadian driver, was fatally injured today in a 170 mile-an-hour crash during the qualifying for the Belgian Grand Prix," *New York Times*, May 9, 1982; Mike Delnagro, "A roundup of the week May 3-9," *Sports Illustrated*, (May 17, 1982) at 101.

Additionally, the *New York Times* carried numerous articles about Mr. Villeneuve's races before his death: *see, e.g.*, "Villeneuve First at Monte Carlo in Ferrari as only 7 of 20 Finish," *New York Times* (June 1, 1981) at C-11; and he is mentioned in several articles after his death as an iconic driver. *See* Shav Glick, "New Look Is Served a la CART; With changes in series, Long Beach Grand Prix is same in name only," *New York Times* (April 13, 2003) at part 4, page 1; Skip Myslenski, "A Race Course for Connoisseurs: Road America has Everything," *Chicago Tribune* (April 17, 2000).

Several books have been published on the life of Mr. Villeneuve, and are available in the United States, including: Gerald Donaldson, *Gilles Villeneuve: The Life of the Legendary Racing Driver* (1989); Allan de La Plante & Jody Sheckter, *Villeneuve : A Racing Legend* (1998); Koen Vergeer, *Formula 1 Fanatic* (2003); and Rainer Schlegelmilch, *Quentin Spurring, Formula 1 in Camera 1980-89* (2005). These books are currently available through online

booksellers: *see* http://www.amazon.com/s/ref=nb_ss?url=search-alias%3Daps&field-keywords=gilles+villeneuve; and
[http://books.barnesandnoble.com/search/results.aspx?WRD=gilles+villeneuve&box=gilles %20villeneuve&pos=-1](http://books.barnesandnoble.com/search/results.aspx?WRD=gilles+villeneuve&box=gilles%20villeneuve&pos=-1).

Goldstar is well aware of all of these facts and for them to suggest otherwise is disingenuous as best.

9. The Second Motion to Dismiss is Frivolous.

As demonstrated above, Opposers have undeniably and explicitly alleged facts necessary to support all four prongs of an opposition claim under Section 2(a), and many of those facts are well-known to Goldstar and not subject to reasonable dispute. Applicant's motion – its second motion to dismiss filed in this case – is based on willful mischaracterizations of the pleading and the applicable law and is completely without merit. Opposers have been forced once again to incur considerable expense for their counsel to oppose this frivolous motion, and an appropriate sanction is therefore warranted. Opposers ask that pursuant to the Board's inherent power to sanction and manage its own docket that Applicant be required to answer the Amended Notice of Opposition within twenty days with no further extensions, and that Applicant be barred from filing any further dispositive motions until discovery is completed. *See Trademark Trial and Appeal Board Manual of Procedure*, § 527.03 (describing the Board's inherent authority to sanction).

CONCLUSION

For the foregoing reasons, Opposers Joanna Villeneuve and Mélanie Villeneuve respectfully request that the Board deny Applicant's Second Motion to Dismiss, issue a new scheduling order, and grant such other and further relief as the Board deems just and proper.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and accurate copy of the foregoing document was served on October 9, 2009, upon counsel for Applicant by e-mail and by first class mail, postage prepaid, addressed to:

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